

Amendment and Response*Serial No.: 09/929,417**Confirmation No.: 1221**Filed: 14 August 2001**For: COMPOSITE PAVEMENT MARKINGS****Page 8 of 14*****Remarks**

The Office Action mailed 15 May 2003 has been received and reviewed. Claims 1 and 15 having been amended, the pending claims are claims 1-31, of which claims 1-24 are currently under examination.

Claims 1 and 15 have been amended to more fully claim the present invention. Support for the amendment to claim 1 is found in the specification at page 7, lines 14-16. Support for the amendment to claim 15 is found in the claims as filed. No new matter has been added as a result of these amendments.

Reconsideration and withdrawal of the rejections in view of the above amendments and the following comments are respectfully requested.

The 35 U.S.C. §102 Rejection

The Examiner rejected claims 1-3, 7-9, 14, and 23-24 under 35 U.S.C. §102(b) as being anticipated by Eigenmann (U.S. Patent No. 4,129,673). Applicants respectfully traverse this rejection.

For a claim to be anticipated under 35 U.S.C. § 102(b), each and every element of the claim must be found in a single prior art reference (M.P.E.P. §2131). Applicants respectfully assert that Eigenmann fails to teach each and every element of claims 1-3, 7-9, 14, and 23-24 and, therefore, Eigenmann fails to anticipate these claims.

Applicants' claim 1 is directed to composite pavement marking including a first portion including a first portion width, a unitary retroreflective article attached to the first portion of the pavement marking, and a second portion surrounding the first portion on at least two opposing sides. As amended, this claim recites that the unitary retroreflective article has a width that is substantially equal to the first portion width. Applicants respectfully assert that Eigenmann does not teach a unitary retroreflective article having a width that is substantially equal to the first portion width.

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Eigenmann teaches a roadway surface marking tape including retroreflective elements upwardly protruding over the generally planar surface of the tape and further protruding components for the raising of snowplow implements over the retroreflective elements (Eigenmann, Abstract). The retroreflective elements, E, are partially embedded within the mono- or multi-layer structure of the marking tape, but substantially and sharply protruding or jutting above the generally planar upper face of the tape (Eigenmann, col. 3, lines 35-39). As seen in Figure 3, for example, the retroreflective articles, E, are discrete articles embedded randomly in the marking tape. Figure 3 does not teach a unitary retroreflective article having a width that is substantially equal to the first portion width of the tape.

Furthermore, as can be seen in Figures 8 and 10-11, the retroreflective elements E' also are not a unitary retroreflective article having a width that is substantially equal to the first portion width. Each of the individual retroreflective articles placed in a row include spaces between them (Figures 10 and 11) and, further, the row of retroreflective elements does not extend along a width that is substantially equal to the first portion width, as there is a side portion 30 as well as a space between the retroreflective element at the end of a row and the side of the first portion width (Figure 8). Therefore, Figures 8 and 10-11 do not teach a unitary retroreflective article having a width that is substantially equal to the first portion width.

As Eigenmann fails to teach, either in the specification or in the drawings, a composite pavement marking including a first portion including a first portion width, a unitary retroreflective article attached to the first portion of the pavement marking, and a second portion surrounding the first portion on at least two opposing sides wherein the unitary retroreflective article has a width that is substantially equal to the first portion width, Applicants respectfully assert that present claim 1, and claims 2, 3, 7-9, and 14, directly or indirectly dependent thereto, are novel in view of Eigenmann.

Additionally, Applicants' claim 23 is directed to composite pavement marking having a marking length and a marking width transverse to the marking length and including a first portion including a first portion width, a unitary retroreflective article attached to the first portion

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of the pavement marking, and a second portion surrounding the first portion on at least two opposing sides. The unitary retroreflective article extends along substantially all of the marking length. Applicants respectfully assert that Eigenmann does not teach a unitary retroreflective article that extends along substantially all of the marking length.

There is no teaching in the specification of Eigenmann of a unitary retroreflective article that extends along substantially all of the marking length of the roadway surface marking tapes. Furthermore, there is no indication that the discrete retroreflective elements, E, extend along substantially all of the marking length. The elements, E, appear to be randomly spaced along the marking tape, and there is no indication that the elements extend along the tape with substantially no portion of tape along its length without a retroreflective element. Therefore, Eigenmann fails to teach a pavement marking wherein a unitary retroreflective article necessarily extends along substantially all of the marking length.

Applicant, therefore, respectfully submits that Eigenmann fails to anticipate Applicants' claims 1 and 23, as well as claims 2, 3, 7-9, 14, and 24, directly or indirectly dependent thereto. Reconsideration and withdrawal of the rejection is respectfully requested.

The 35 U.S.C. §103 Rejections

The Examiner rejected claims 4-6, 13, 15-18, 21, and 22 under 35 U.S.C. §103(a) as being unpatentable over Eigenmann (U.S. Patent No. 4,129,673) in view of Wyckoff (U.S. Patent No. 5,108,218). Applicants respectfully traverse this rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations (M.P.E.P. §2143).

Initially, Applicants assert that there is no motivation to combine Eigenmann with Wyckoff. Eigenmann teaches a roadway surface marking tape material including components for

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raising snowplow implements over retroreflective elements, thus preventing destruction of the retroreflective elements by the snowplow (Eigenmann, Abstract). Wyckoff, conversely, teaches a roadway marking strip wherein a flat rubber sheet is coated with glass beads, and embossed with a wedge pattern embossing drum such that, during the process of embossing, the surface of the rubber sheeting is deformed in the glass beaded area only, and the beads are partially pressed into the wedge tops and near vertical faces of the wedges and almost completely pressed into the valley floors (Wyckoff, column 4, lines 35-58). It is respectfully asserted that as the glass beads of Wyckoff's roadway marking strip are embossed into the rubber sheeting, there is no need to provide Eigenmann's components to raise snowplow implements over the embossed beads. Thus, there is no motivation for one skilled in the art to combine the teachings of Eigenmann with those of Wyckoff.

Furthermore, a combination of Eigenmann with Wyckoff fails to teach or suggest Applicants' claims. As discussed above, Eigenmann fails to teach claim 1 and those claims dependent thereto. Wyckoff fails to teach that which is missing from Eigenmann.

Wyckoff fails to teach or suggest a composite pavement marking including a first portion and a second portion surrounding the first portion on at least two opposing sides, as recited in claim 1. Furthermore, Wyckoff fails to teach or suggest a unitary retroreflective article attached to a first portion wherein the unitary retroreflective article has a width that is substantially equal to the first portion width (claim 1) or a composite pavement marking as in claim 1 further comprising a plurality of discrete first portions surrounded by a second portion, each of the plurality of first portions comprising a discrete unitary retroreflective article attached thereto (claim 15).

For the foregoing reasons, Applicants respectfully submit that claims 4-6, 13, 15-18, 21, and 22 are nonobvious over Eigenmann in view of Wyckoff. Reconsideration and withdrawal of the rejection is, therefore, respectfully requested.

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The Examiner rejected claims 10-12 under 35 U.S.C. §103(a) as being unpatentable over Eigenmann (U.S. Patent No. 4,129,673) in view of Jonnes (U.S. Patent No. 3,785,719).

Applicants respectfully traverse this rejection.

Applicants assert that there is no motivation to combine Eigenmann with Jonnes.

Eigenmann teaches a roadway surface marking tape material including components for raising snowplow implements over retroreflective elements, thus preventing destruction of the retroreflective elements by the snowplow (Eigenmann, Abstract). Jonnes, conversely, teaches a roadway lane delineator including an integrally formed base portion and reflector portion that forms a retroreflective structure, wherein the retroreflective structure elastically deforms when engaged by a vehicle passing over the structure (Jonnes, column 1, lines 52-59 and column 1, line 65 to column 2, line 5). As the retroreflective structure of Jonnes is intended to deform upon contact by a passing vehicle, there is no motivation for one skilled in the art to combine the teachings of Jonnes with those of Eigenmann, which provide components for raising a vehicle over retroreflective elements, thus preventing damage to the elements.

For the foregoing reasons, Applicants respectfully submit that claims 10-12 are nonobvious over Eigenmann in view of Jonnes. Reconsideration and withdrawal of the rejection is, therefore, respectfully requested.

The Examiner rejected claims 19-21 under 35 U.S.C. §103(a) as being unpatentable over Wyckoff (U.S. Patent No. 5,108,218) in view of Wyckoff as applied to claims 4-6, 13, 15-18, 21, and 22 above, and further in view of Jonnes (U.S. Patent No. 3,785,719).

As indicated above, there is no motivation to combine the teachings of Eigenmann with the teachings of Wyckoff, and there is no motivation to combine the teachings of Eigenmann with the teachings of Jonnes. There is also no motivation to combine the teachings of Wyckoff with the teachings of Jonnes.

As indicated above, Wyckoff teaches a roadway marking strip wherein a flat rubber sheet is coated with glass beads, and embossed with a wedge pattern embossing drum such that, during

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the process of embossing, the surface of the rubber sheeting is deformed in the glass beaded area only, and the beads are partially pressed into the wedge tops and near vertical faces of the wedges and almost completely pressed into the valley floors (Wyckoff, column 4, lines 35-58). Jonnes, conversely, teaches a roadway lane delineator including an integrally formed base portion and reflector portion that forms a retroreflective structure, wherein the retroreflective structure elastically deforms when engaged by a vehicle passing over the structure (Jonnes, column 1, lines 52-59 and column 1, line 65 to column 2, line 5). That is, the retroreflective structure of Jonnes is intended to come into contact with a passing vehicle, which, Applicants assert, would not occur with the embossed roadway marking strips of Wyckoff. Further, Jonnes teaches that it is disadvantageous to use roadway delineators including retroreflectors set in a recess, as the recesses tend to fill with dust that obstructs the passage of light rays to the reflectors (Jonnes, column 1, lines 33-37). Thus, there is no motivation for one skilled in the art to combine the teachings of Wyckoff with those of Jonnes.

Applicants respectfully submit that claims 19-21 are nonobvious over Wyckoff, as applied to claims 4-6, 13, 15-18, 21, and 22 above, and further in view of Jonnes. Reconsideration and withdrawal of the rejection is respectfully requested.

For the foregoing reasons, Applicants respectfully submit that the present claims are not obvious in view of Eigenmann, Wyckoff, and Jonnes. Reconsideration and withdrawal of the above rejections are, therefore, respectfully requested.

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Summary

It is respectfully submitted that the pending claims 1-24 currently under examination are in condition for allowance and notification to that effect is respectfully requested.

The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Assistant Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 15th day of SEPTEMBER, 2003, at 2:48 pm (Central Time).

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